

## **DETAILED ACTION**

### **Specification**

It appears that the title is too long and non-descriptive (See 37 CFR 1.72).

### **Claim Status**

Claims 1-13 are currently pending in the Instant Application.

### **Claim Objections**

Claims 1-13 are objected to because of the following informalities-

The claimed invention should be reviewed to correct a plurality of improprieties therein.

First, in the claimed invention, there should be "one single space" between each word.

For example, in claim 1, "printedmatterbeing" (preamble) should be - printed matter being- .

Further, in claim 9 (preamble), "Aprintingmethodof" and "printedmatter" should be - A printing method of- and - printed matter- .

Second, in the claimed invention, elements like "(step 1), (step 2), (step 3), (step 4) and (step 5)", as seen in claim 1 for example, should be removed from the claims.

Claim 3, "A printing method of..." should apparently be - A printing ink system."

Throughout the claimed invention, especially in claim 4, "a printing ink (b-1)", "a printing ink (b-2)", "a printing ink (b-3)", "a printing ink (b-2-1)", "a printing ink (b-2-2)", "a printing ink (b-3-1)" and "a printing ink (b-3-2)" should apparently be - a printing ink - .

Appropriate corrections are required.

**Claim Rejections - 35 USC § 101**

**35 U.S.C. 101 reads as follows:**

**Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

Claim 9 (including its dependent claims) is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to a “particular machine” (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here, the claim or at least independent claim 1 fails to meet the above requirements because the steps are neither tied to a “particular machine” (such as a particular apparatus), nor do they physically transform the underlying subject matter (such as an article or materials) to a different state or thing. **To be statutory, at least one or more significant steps or a combination thereof should include a “particular machine”. However, the claim does not contain any step or act, which often characterizes a method step or process claim.**

Further, the Examiner notes that Applicant may show that a process claim satisfies §101 either by showing that Applicant's claim is tied to a particular machine, or by showing that

Applicant's claim transforms an article (See Benson, 409 U.S. at 70). Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See Flook, 437 U.S. at 590).

**Claims 1 and 9 (including its dependent claims) is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Although it appears that claim 1 recites a “system” in the preamble, suggesting a structure, however, the body of the claim does not include any structure (hardware), which often characterizes a system. To this end, the claim appears to switch statutory class, which, under 35 USC 101, renders the claim non-statutory. The claim just recites a collection of data.

Similarly, although it appears that claim 9 recites a “method” in the preamble, suggesting a method step (process or act), however, the body of the claim does not include any step or act, which often characterizes a method-step. To this end, the claim appears to be non-statutory. The claim just recites a collection of data.

**Claim 1 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.**

Claim 1 is rejected under 35 U.S.C. §101 as being drawn to non-statutory subject matter. Claim 1 recites, first claim limitation, “a purchaser”. Here, it appears that Applicant claims a

“human being”. As per the *MPEP §2105 Patentable Subject Matter- Living Subject Matter* states, “If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. §101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.” Here, “a purchaser” is a human being and thus, the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being. Having said that, the claim stands rejected under 35 USC 101 for claiming a human being (living species).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claimed invention appears to be confusing since it is difficult to understand or interpret the claim language. In other words, the metes and bounds of the claims are not well defined so as to enable an ordinary skilled artisan to understand, practice or implement the claimed invention. For instance, claim 1 recites in the preamble “A printing ink system for printing a printed matter for IT-dependent, printed-matter-linked shopping, said printed matter being useful in a sales method of a merchandise

that:”. As seen above, it is unclear whether the claim recites a system or a merchandize.

Applicant should attempt to amend the claim to recite - **-A printing ink system for printing a printed matter for IT-dependent or printed-matter-linked shopping, said printed matter being useful in a sales of a merchandise, the system comprising:** - -. The same deficiency appears in claim 9 and should be addressed accordingly.

Furthermore, although it appears that claim 1 recites a “system” in the preamble, suggesting a structure, however, the body of the claim does not include any structure per se. To this end, the claim appears to be confusing. Similarly, although it appears that claim 9 recites a “method” in the preamble, suggesting a method step (process or act), however, the body of the claim does not include any step or act per se. To this end, the claim appears to be confusing.

Throughout the claimed invention, the use of auxiliary verbs “can” and “may”, as seen for example in claim 1, renders the claims indefinite.

In general, throughout the claimed invention, although the acronym “IT” in IT-dependent maybe well known, however, it renders the claims indefinite since “IT” should be defined at least once in the claim.

Applicant is also encouraged to correct other improprieties that may be present in the claims.

Finally, the claims will be given their broadest interpretation based on what can be understood from the claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Scroggie, WO 97/23838.**

As per claims 1-13, Scroggie discloses a system and method for delivering purchasing incentives and a variety of other retail shopping aids through a computer network, such as by E-mail over the Internet or the World Wide Web. Customers (10) of retail stores can establish a bidirectional communication link with the system, log in (16) to the system and then elect to browse among available purchasing incentive offers (18, 22), or elect to explore other shopping aids, such as a shopping list generator (26), a recipe center (30), or simply elect to claim a product rebate or to receive product information. If the customer elects to have product information or rebate information delivered, only minimal customer identification is required. For purchase incentives redeemable at retail stores, the customer must provide identification information and must also designate a retailer (12) at which the purchasing incentive can be exercised. For receipt of focused incentives based the customer's past shopping behavior, the customer must also supply a unique customer id., such as a check cashing card number or credit card number, used for in-store purchases. For delivery of a product sample, the customer's name

and address must be supplied. The system merges this customer-supplied information (270) with other purchase incentive data (272) and creates a printable graphical image of the purchasing incentive (282) for transmission to the customer. In an alternate embodiment of the invention, the purchase incentive is not transmitted directly to the customer. Instead, the terms of the incentive are transmitted electronically to the retail store (310) designated by the customer, who receives either a token (316) to present at the store or an advisory message. In yet another embodiment of the invention, incentives may be targeted to specific consumers based on a consumer purchase history (502), and transmitted to consumers' computers (510) using electronic mail addresses stored in a consumer database (506), or using a "personal page" in the computer network, established for each consenting consumer (See abstract).

The present system resides in a system and method for the distribution, via a computer network, of incentives and other related shopping aids useful to retail customers. Importantly, the incentives are distributed in such a way that they may be redeemed only at a specific retailer selected by each customer (p. 1: 25-30). Briefly, the system comprises a sequence of steps performed at a central site in cooperation with a communication device at a customer site. The steps include logging in a remotely located customer using identity data and geographic region data transmitted by the customer over a communication network; transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region; and then receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised. In response to the customer selection data, the method performs the steps of generating a purchasing incentive containing (in encoded

form) the identity of the retailer designated by the customer and the identity of the customer; and transmitting at least one incentive to the customer over the communication network, for subsequent printing by the customer. For security reasons, the transmitted incentive may be encoded with the identity of the retailer selected by the customer, and preferably also contains a customer identification code (p. 2: 1-15). The present system permits the customer to plan his or her shopping and shopping-related activities more efficiently. To this end, the method also includes the step of communicating with the customer concerning the use of shopping aids other than incentives or coupons. In one aspect of the, the communicating step includes transmitting a list of products available for purchase, receiving customer selections from the list of products and then transmitting a shopping list to the customer. Thus, the customer may browse through a list or index of available products, preferably organized by store department, and then make selections by marking appropriate entries on a computer screen, such as by positioning a mouse pointer on the desired items and clicking a mouse button (p. 2: 16-25).

Scroggie teaches, as shown in fig. 1, a system or a portal (platform) for providing a unique communication network (such as the Internet) connecting consumers (i.e. users), indicated at block 10, retailers 12 (i.e. users) and manufacturers 14 (i.e. users). The consumers 10 log in and fulfill log-in requirements as indicated in block 16, and may then proceed to a main menu 20. From the main menu 20, a consumer may elect to go to an offer browser index page 18, to conduct a transaction related to the sale of a product at a retailer, which is linked to an offer browser 22. The offer browser 22 has associated sub-offers 24 available for consumer selection. Basically, the offer browser 22 receives offer data from the manufacturers 14 on a periodic basis, and displays the offers to consumers 10, via the portal, who have logged in to the



system. The offer and sub-offer structure (engine) permits consumers to select coupon offers/rebate offers, related to a product for sale, or information offers made available by the manufacturers, wherein the (product) information is provided to the consumers via the portal. Selected offers are accumulated in a session record maintained for the time that each consumer is logged in to the system.

Further, from the main menu 20, a consumer may elect to go to a shopping list 26, under which store departments 28 **provide lists of products for sale**. The consumer may mark any items for entry on a shopping list to be printed later. The consumer may also elect to go from the main menu to a recipe index 30, which provides a linkage to previously stored recipes 32. In response to consumer selection of a recipe 32, the ingredients are automatically entered into the consumer's final shopping list, and any coupon offers or rebate offers associated with any of the ingredients are also automatically included in the final list to be transmitted to the consumer. A consumer may also elect to go from the main menu 20 to a supermarket special index 34, which has linkages to previously stored supermarket special offers 36. These have been entered and periodically updated by the retailers 12. Again, any selected items are automatically entered into the consumer's final shopping list.

When the consumer has finished selecting from the offer browser 22, the shopping list index 26, the recipe index 30 and the supermarket special index 34, he or she may elect to go the final list 40. Prior to generation of the final list, the consumer will be required to enter a valid Internet address for electronic mail (E-mail) **and to select a supermarket in his or her area, as indicated in block 42 where products in the shopping list can be purchased or processed when related coupons are redeemed**. Once the final list has been generated, the consumer may

elect to leave the system through an exit page 44, which may have links to other areas of the system (portal).

See p. 8: 28 to p.10: 2; p. 10: 5 to p.11: 13; p. 11: 15 to p. 12: 8; p. 12: 10 to p. 14: 21; figs. 1-18.

In addition, unlike coupons printed for distribution by mail or printed on an in-store printer, the coupons distributed over the Internet, in accordance with the present system, are created in real time to include information provided by the consumer at his or her remote location. Thus, each coupon image is generated dynamically to include this consumer-supplied information, which is required principally for security reasons. Each coupon contains not only a product code and coupon conditions, but also the consumer's name or household ID., the retailer ID, where the coupon must be redeemed and a coupon sequence number for added security. Merging all the received information into a graphical image in a real-time mode for transmission over the computer network produces a printable coupon image as shown in fig. 11. More specifically, the input information that has to be incorporated into each coupon includes the consumer's name and the location coordinates for location on the coupon, the coupon expiration date and its coordinates, the logo of the system and its coordinates, the product offer icon and its coordinates, the amount of savings and its coordinates, the terms for receiving savings amount and its coordinates, the legal text and its coordinates, the redemption text and its coordinates, the coupon sequence number and its coordinates, the bar code numbers and their coordinates, the supermarket designation and its coordinates and the coupon size and border parameters (p. 16: 5-30). See p. 16: 5 to p. 18: 18.

**Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Barnett et al. (hereinafter Barnett), US Patent 6, 321, 208B1.**

As per claims 1-13, Barnett discloses a system for distributing in an interactive manner over the Internet by an online service provider 2 electronic coupons received from issuer 14 or distributor 16 to registered users using remote computers 6 of fig. 1 wherein, upon connecting or logging into online service provider system having a web site subsequent to inputting by a user his identification number and login name, the user can download targeted coupon data to his hard drive for later retrieval. The coupon data can be used by the user to print at least a coupon 70 as shown in fig. 5 comprising at least a bar code 90 representing a user's unique identification number such as his social security number and/or online service address or e-mail address, the UPC bar code 84 and number 82 of the product associated with the particular printed coupon, redemption instructions 88, the coupon value 74 and so on and so forth. When the printed coupon 70 is presented by the user at a participating retail store 10 for redemption, the value 74 is used to reduce the total transaction amount if a product matching the UPC code 84 is purchased. Upon redemption by the retail store 10 via a coupon redeeming center or service center 13, which verifies that the coupon data were not altered, transaction data are transmitted to issuer 14 or distributor 16 for integration into marketing analysis in order to prepare special coupon packages for the said user based on his demographic profile and transaction history including redeemed coupons. The electronic coupon system is fraud proof and secure due to the inclusion of the user-specific identification indicia printed or encoded or encrypted on the coupon 70. Further, the coupon data can be forwarded by the user directly to a designated retail

store 10 for subsequent use by the user during a redemption process. In another embodiment, the coupon distribution can be conducted online, thereby eliminating the need for the user to print the coupon. Here, the functions of the online service provider 2 are carried online on the Internet, wherein the identified user may access the coupon data repository (coupon data stored in D/B 40 of fig. 6) by logging into a web site related to online service provider 2. The downloaded or local coupon management routine 32 functions are encoded with a unique user's identification number, which may be for example, the user's e-mail address. When the user requests coupon data packages from the data repository or D/B 40, the user's identification number is encrypted and sent to the web site related to online service provider 2 along with the request. Appropriate routines are implemented at the said web site to decrypt the user's identification number and compare it against a list of valid members in order to ensure the validity of the user. Finally, a coupon can be redeemed only once, thereby preventing the user and/or the retailer from committing fraud (See abstract; figs. 1-6 and 9; col. 4: 40 to col. 5: 61; col. 6: 65 to col. 7: 55; col. 8: 22-48; col. 10: 1-16; col. 10: 24-30; col. 10: 50-56; col. 11: 11-43; col. 13: 50-62).

Further, the online service provider 2 has means to determine how many times a particular coupon was selected or viewed or requested. In an alternative embodiment, the coupon may be redeemed electronically by sending the coupon data from the user's remote computer 6 via the data communication 20 back to the online service provider 2. This is especially useful in the electronic shopping mall environment now found in many online services. Needless to say here that payment instruments, such as credit/debit card, etc., will be used to pay for the online transaction, which will be reduced based on the value 74 of the coupon if a matching product is bought by the user, wherein credit/debit card authorization or validation is performed by a

credit/debit card company or financial institution accordingly, as known in the art. It is contemplated that the shopping mall or online retailer 10 will be credited or compensated accordingly for accepting and/or redeeming the coupon (See abstract; figs. 1-6 and 9; col. 4: 40 to col. 5: 61; col. 6: 65 to col. 7: 55; col. 8: 22-48; col. 10: 1-16; col. 10: 24-30; col. 10: 50-56; col. 11: 11-43; col. 13: 50-62).

### **Conclusion**

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Ms. Lynda Jasmin, can be reached at (571) 272-6782

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/J.J./

/Jean Janvier/

Primary Examiner, Art Unit 3688